



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO. 08/557,161	FILING DATE 04/22/97	FIRST NAMED INVENTOR NEWTON W	ATTORNEY DOCKET NO.
-------------------------------	-------------------------	----------------------------------	---------------------

EUGENE S STEPHENS
EUGENE STEPHENS & ASSOCIATES
56 WINDSOR STREET
ROCHESTER NY 14605

PM32/0226

EXAMINER COHEN, C

ART UNIT 3634	PAPER NUMBER
------------------	--------------

DATE MAILED: 02/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/839,161

Applicant(s)

Newton et al

Examiner

Curtis Cohen

Group Art Unit

3634



☒ Responsive to communication(s) filed on Dec 7, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-90 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 and 29-90 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 26-28 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3634

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 12-16, 19-21, 53-58, 60, 67, 68, 69, 74, 75, 79-81, 85, 86 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten, Sr. #2,987,758. Osten, Sr. teaches a movable sash 20 mounted in a window frame 12 having sash guides 14. Sash support arms 50 are pivotally mounted on a pivot 44 between an outwardly and a downwardly extending position. The arms 50 rest on a pair of sash shoes 92 as best shown in Figure 1. In the inwardly extending position, the arms can touch an outer region of the shoe, and in the outwardly extending position the arms can touch the inner region of the shoe. A counterbalance is applied to a hook region which is above the outer platform region of the shoe. A locking element is taught by the surface 102. In column 2, lines 1-6, Osten, Sr. discloses that it is known to use extrusion as a manufacturing technique. Claim 12, the preamble of this claim indicates a Jepson type claim where the structure indicated in the preamble of the claim is admitted prior art. Therefore, the burden of the examiner is to provide evidence of the subcombination of the structure listed in sections a-c of claim 12. However, Osten, Sr. meets the requirements for a 102(b) by teaching all of the limitations in the preamble and the limitations in sections a-c. The shoe of Osten, Sr. also

Art Unit: 3634

comprises a guide 110 which guides the shoe and window along a track 114. A retaining groove is taught by the eyelet of hook 84.

Claims 29, 30, 32-34, 39-44, 46-48 and 61-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Haas. Haas teaches that it is known in the art to provide a pivotally mounted locking means 92 mounted on a pin in a pin groove (or slot) on a sash shoe 65 which is adapted to lockingly engage the partition walls, see column 3, lines 15-22. A spring latch 70 retains the hook in an undeployed position and it is capable of being manually moved or moved with a tool. A guide 64 is mounted on the shoe 65.

Claims 8-10, 17, 18, 22-25, 70, 71, 73, 76, 77, 78, 82-84 and 87-89 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Osten, Sr. Considering the Section 112(2nd) rejection above, Osten, Sr. teaches the invention as discussed in the rejection above. Osten, Sr. does not disclose to what particular dimension the metal is intended to be sized. However, applicants' claims do not define a particular structural feature that would distinguish from Osten, Sr. and Haas. Therefore, it is inherent that one of ordinary skill would make shoes and the arms to fit whatever size window for which they are installed.

Claims 31, 49-51, and 64-66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haas. Considering the Section 112(2nd) rejection above, Haas teaches the invention as discussed in the rejection above. Haas does not disclose the particular function of what size the metal is intended to be sized. However, it is

Art Unit: 3634

inherent that one of ordinary skill would make shoes and the arms to fit whatever size window for which they are installed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten, Sr. as applied to claims 1-4, 7, 12-16, 19-21, 53-58, 60, 67, 68, 69, 74, 75, 79-81, 85, 86 and 90 above and in further view of Haas #2,791,795. With respect to claims 5 and 6, Osten, Sr. does not disclose locking elements being pivotally mounted on the shoes. Haas teaches that it is known in the art to provide a pivotally mounted locking means 92 on a sash shoe which is adapted to lockingly engage the partition walls, see column 3, lines 15-22. A spring is provided to bias the locking means in an undeployed position. For this reason, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Osten, Sr. with a pivotally mounted locking member as taught by Haas.

Claims 35-38 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas as applied to claims 29, 30, 32-34, 39-44, 46-48 and 61-63 above, and in further view of Osten, Sr. Haas discloses the invention as taught in the Section 102 rejection above including a locking slot 96. Haas does not disclose the shoe 64 being formed of a resin material. Osten, Sr. teaches

Art Unit: 3634

that it is known in the art to form a shoe guide 110 out of a resin material as described on column 3, lines 45-49, to reduce the frictional noise created by the known metal guides when they contact the metal channels. For this reason, it would have been obvious to one having ordinary skill in the art at the time of applicants' invention, to provide Haas with a guide formed from a resin material as taught by Osten, Sr.

Claims 11, 59, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten, Sr. Osten, Sr. teaches the invention as discussed in the Section 102(b) rejection above. Osten, Sr. lacks a support arm having extruded coding lines indicating the length of the support arm. Coding symbols are well known in the art of manufacturing. One example of this teaching is on the head of a bolt which has different coding lines indicating the different strengths of each bolt. Therefore, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Osten, Sr. with code lines to indicate the length of the arm.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haas as applied to claims 31, 49-51, and 64-66 above. Haas teaches the invention as discussed in the Section 102(b)/103 rejection above. Haas lacks a support arm having extruded coding lines indicating the length of the support arm. Coding symbols are well known in the art of manufacturing. One example of this teaching is on the head of a bolt which has different coding lines indicating the different strengths of each bolt. Therefore, it would have been obvious to one having ordinary

Art Unit: 3634

skill in the art, at the time of applicants' invention, to provide Haas with code lines to indicate the length of the arm.

Response to Arguments

Applicants' arguments filed December 7, 1998 have been fully considered but they are not persuasive.

Applicants state on page 16 of the amendment that the present claims do not deal with extrusion as a process but as a structural limitation. Applicants point out that the term "extrusion" imparts the definition of "formed from an evenly extending profile" to the element. This structural limitation is not imparted into the meaning of the term "metal extrusion." If it is applicants' intent for the term "metal extrusion" to mean, "formed from an evenly extending profile" then that language should be inserted into the claim. The language "having a predetermined profile" is not inclusive only of extruded members. Most manufactured pieces have a predetermined profile, usually in the form of either a technical drawing or a scale model. It is readily apparent that the shoes of Osten, Sr. have a profile that was "predetermined."

Applicants argue on page 17, that Osten, Sr. requires a spring biased member which causes more friction in the window and also scars the jambs. It is believed that the language of the claim 1, "to pivot freely" is met by the structure of Osten, Sr. The arm of Osten, Sr. is not locked into a position, therefore it is considered to pivot "freely." What structure have applicants set forth in the claims that would preclude the mechanism of Osten, Sr. as a relevant teaching?

Art Unit: 3634

Applicants also argue that the weight of the sash in Osten, Sr. and Haas is applied on the sash shoes in regions not directly below the counterbalance. This may be the case, however there is no limitation in claims that states that the weight is applied "directly below the shoes." Accordingly, applicants' arguments are not commensurate with the scope of the claims and therefore have not been considered further.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-3598.

Application/Control Number: 08/839,161

Page 8

Art Unit: 3634

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen

February 25, 1999

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looped initial "D".

Daniel P. Stodola
Supervisory Patent Examiner
Group 3600